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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,363	11/13/2001	John Andrew Storer	OSTEONICS 3.0-323	7040
530	7590	03/31/2004		
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER ROBERT, EDUARDO C	
			ART UNIT 3732	PAPER NUMBER //

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/054,363

Applicant(s)

STORER ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/23/04.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 and 14-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election of Invention I, claims 1-8 and 14-23, and Species III, i.e. Figure 12 (cement deflector 70), in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, **the election has been treated as an election without traverse** (MPEP § 818.03(a)).

It is acknowledged that applicants believe claims 1-8 and 14-23 read on the elected Species III, i.e. Figure 12 (cement deflector 70). It is noted that comparison of the claims with Species III, i.e. Figure 12 (cement deflector 70), and the specification shows, however, that the species of Figure 12, i.e. cement deflector 70, does not have a sheath and a deflector as required in the bone cement deflector of claims 1-8. Moreover, amended claim 1 recites new matter because the specification as original filed does not disclose **a bone cement deflector** comprising a sheath and a deflector. It is noted that as originally disclosed, the bone cement deflectors are disclosed as being cement deflector 55 (Species I, Figure 9), cement deflector 60 (Species II, Figure 11), cement deflector 70 (Species III, Figure 12), cement deflector 80 (Species IV, Figure 13), and cement deflector 93 (Species V, Figure 14) and the specification discloses that two cement deflector can be used together as show in Figure 16. However, there is no disclosure of a cement deflector with a sheath and deflector, as now claimed in claim 1.

Furthermore, comparison of the claims with the Species III, i.e. Figure 12 (cement deflector 70), and the specification shows, however, that the species of Figure 12, i.e. cement deflector 70, is not adapted to extend over the insertion portion of a prosthesis from its distal end to a position at or adjacent to its proximal end as required in claims 14-18. It is noted that the

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cement deflector recited in claim 14 appears to be directed to the non-elected Species I, Figure 9, i.e. cement deflector 55.

Also, comparison of the claims with the Species III, i.e. Figure 12 (cement deflector 70), and the specification shows, however, that the species of Figure 12, i.e. cement deflector 70, is not sheath which extends over the insert portion of the prosthesis from its distal end to a position at or adjacent to its proximal end as required by claims 19-23. It is noted that the cement deflector recited in claim 19 appears to be directed to the non-elected Species I, Figure 9, i.e. cement deflector 55.

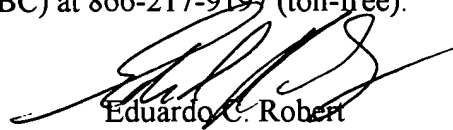
Thus, the elected Species III does not read on any of the pending claims 1-8 and 14-23. Because of that, the reply filed on January 23, 2004 is not fully responsive to the prior Office Action because of the following matter(s): claims 1-8 and 14-23 are not readable on the elected Species III, i.e. Figure 12. Applicant is advised to amend the claims or present new claims directed to the elected Invention I and Species III, i.e. Figure 12. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.